

Atty. Docket No.: 59036-249737

PATENT

**REMARKS**

Applicant appreciates the Examiner's indication that claims 34, 35, 37-42, 52, 53, 55-59, 61, 62, 64-69 and 79-83 are allowable.

Applicant has amended claim 60 to depend from a claim that is not cancelled. Additionally, the Applicant has amended claims 43, 70 and 78 to further include language positively claiming technology and therefore further clarifying that the claimed subject matter falls within the technological arts. Therefore, claims 34, 35, 37-44, 46-53, 55-62, and 64-83 are present for examination.

**35 U.S.C. §112 Rejections**

In the Office action, the Examiner rejected claim 60 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, specifically because it depended from a cancelled claim. In view of the proposed amendment changing the dependence of claim 60 from independent claim 54 into a dependence from independent claim 52, the claim 60 is now thought to distinctly claim the subject matter which applicant regards as the invention.

**35 U.S.C. §101 Rejection**

The Examiner has rejected claims 43, 44, 46-51 and 70-78 under 35 U.S.C. § 101 asserting that the claimed invention is directed to non-statutory subject matter and that the claimed invention is not within the technological arts.

The Applicant respectfully disagrees with the Examiner's analysis, and submits that claims 43, 44, 46-51 and 70-78 are directed toward statutory subject matter and are within the definition of "technological arts" or "useful arts" either of which qualify as statutory subject matter under a 35 U.S.C. § 101 analysis. However, claims 43, 70 and 78 have been amended to further include one or more alleged elements of "technology," in order to further clarify that such claims are directed to statutory subject matter.

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The Examiner recognized a "two prong" test to determine if an invention is statutory subject matter. Applicant respectfully disagrees with the assertion that before the invention is subject to the State Street test of being "useful, concrete and tangible," the invention must first fall within the "technological arts."

In *Diamond v. Diehr*, 450 U.S. 175 (1981), the Supreme Court stated, "[C]ourts 'should not read into patent laws limitations and conditions which the legislature has not expressed.'" *Id.* at 182 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980)). Accordingly, the U.S. Patent Office should not read speculative limitations and conditions into 35 U.S.C. § 101. Also, in *Diehr*, the Court set forth that "laws of nature, natural phenomena, and abstract ideas" were excluded from patent protection. 450 U.S. at 185. However, when *Diehr* was decided, the *Musgrave* decision and the technological arts test were before it, yet the Court only stated the three categories of nonpatentable subject matter. If the Court desired to set forth "technological arts" as another constitutional limitation on patentable subject matter, the Court would not have omitted "nontechnological" subject matter from its list of excluded subject matter. Accordingly, Applicant respectfully disagrees with the idea that the Court desired to create a fourth category of nonpatentable subject matter under 35 U.S.C. § 101.

The Examiner rejected these claims because the invention is allegedly not within the "technological arts." Even though Applicant respectfully disagrees with the Examiner that an invention must fall within the "technological arts" to be patentable, Applicant sets forth the following analysis explaining how, if there was indeed a "two prong" test for determining if an invention was not patentable subject matter, the claims of the present application satisfy such a test. The Examiner stated in Paragraph 4 of the Office Action, "The phrase 'technological arts' has been created and used by the courts *to offer another view* of the term 'useful arts.'" *See In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970) (emphasis added)." As stated by the Examiner, the phrase "technological arts" was created and used by the courts *to offer another view* of the term "useful arts," *not to replace* the term "useful arts." Accordingly, if there were a "two prong" test as suggested by the Examiner, the first test to determine if an invention was directed

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to statutory subject matter would be to determine if the invention was within the "technological arts" *or* "useful arts" as opposed to Examiner's statement of within the "technological arts" only.

Applicant respectfully points to the language in *Toma*. Applicant acknowledges the Examiner's statement in Paragraph 6 of the Office Action, that the *Toma* court discussed a "technological" arts analysis. However, in *Toma*, the court uses the language "[t]he 'technological' *or* 'useful' arts inquiry must focus on whether the claimed subject matter... is statutory...." One of several interpretations of the *Toma* language is:

If one performs a "technological" arts inquiry one must focus on whether the claimed subject matter is statutory;

*or*

if one performs a "useful" arts inquiry one must focus on whether the claimed subject matter is statutory,

either of which inquiry could be performed when focusing on whether the claimed subject matter is statutory. Accordingly, Applicant respectfully asserts that although there is an indication that "technological arts" could be *another view* of the term "useful arts," there is no indication of the creation of an additional test to determine subject matter that is excluded from Section 101.

The Examiner cites *Ex parte Bowman*, 61 USPQ2D (BNA) 1669 (BdPatApp&Int 2001). as acknowledging the dichotomy of the "technological arts" test and the *State Street* test. However, in *Bowman* the Board states, "we find that the invention before us is nothing more than an abstract idea which is not tied to *any technological art, environment, or machine, and* is not a useful art as contemplated by the Constitution of the United States." Because the Board uses the phrase "any technological art, environment, or machine" this implies that if the invention was any one of the stated terms, technological art, environment, or machine, that it would fall within the "technological arts." Therefore, even if a statutory invention need only to satisfy the separate issue of being within the "technological arts" the invention only needs to be tied to "any technological art, environment or machine" as the Board of Patent Appeals and Interferences (BPAI) acknowledges in *Bowman*. Amended claims 43, 70 and 78 recite, *inter alia*, a "user

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interface screen," which qualifies as "any technological art, environment or machine." Hence, claims 43, 70 and 78 satisfy the "technological arts" prong of the "two prong" test as acknowledged by the Board in *Bowman*, to the extent such test finds support, if any, in other controlling precedential decisions.

Therefore, Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. § 101 rejection of claims 43, 44, 46-51 and 70-78.

However, for the sake of expediting issuance of the present application, the Applicant has also amended these claims without prejudice and reserves the right to pursue claims of similar breadth in one or more continuation applications.

#### COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

The undersigned agrees that the Williams, Edesess and Baird references are deficient individually and in combination with respect to the "identifying a relationship" element of the allowed claims. However, the undersigned believes one or more other limitations of the allowed claims provide independent basis for allowability of the claims.

#### CONCLUSION

The Applicant respectfully submits that the objections and rejections raised in the Office action have been overcome by the amendment and remark, and that the pending claims are in condition for allowance. Accordingly, the Applicant respectfully requests that the rejections be withdrawn and that a Notice of Allowance be promptly issued for claims 34, 35, 37-44, 46-53, 55-62 and 64-83.

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**INVITATION FOR A TELEPHONE INTERVIEW**

The Examiner is requested to call the undersigned at (303) 607-3633 if there remains any issue with allowance of the case.

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Respectfully submitted,

FAEGRE & BENSON LLP

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